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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/703,783	11/01/2000	Yoshitaka Nakamura	P/2856-18	2457
7590	07/13/2004			EXAMINER HESSELTINE, RYAN J
STEVEN I WEISBURD ESQ DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS 41st FLOOR NEW YORK, NY 10036-2714			ART UNIT 2623	PAPER NUMBER
			DATE MAILED: 07/13/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/703,783	NAKAMURA ET AL.
Examiner	Art Unit	
Ryan J Hesseltine	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 29 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 2-8 and 11-13 is/are allowed.
- 6) Claim(s) 1 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 01 November 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                             |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                        | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments on page 9, first and third paragraphs, filed April 29, 2004, with respect to the title, the abstract, and claims 3 and 5 have been fully considered and are persuasive. The objections of the title, abstract and claims have been withdrawn.
2. Applicant's arguments on page 9, fifth and sixth paragraph onto page 10, filed April 29, 2004 have been fully considered but they are not persuasive. On page 9, fifth paragraph, applicant states, "Among the features of claim 1 not taught or suggested in the cited references is the recited lens selection means, provided within the enclosure, for selecting one of the first lens and the second lens by varying the position of at least one of the first lens and the second lens so that a focal point of a selected lens is established at the imaging element." The examiner agrees that Robb (USPN 6,177,950) does not teach such a feature, but the examiner believes that Borza (USPN 5,680,205) teaches such a lens selection means (see rejection below).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robb (USPN 6,177,950, previously cited) in view of Borza (USPN 5,680,205, previously cited).
5. Regarding claim 1, Robb discloses a portable information terminal device (multiphone 20) comprising: an enclosure (rectangular body) of said portable information terminal device

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(Figure 1; column 5, line 24-36), an imaging element (reading head, camera 2) provided within said enclosure (column 5, line 36-47), a first lens (93) provided within said enclosure for said imaging element, a second lens (94), a focal length of which being shorter than that of said first lens (column 3, line 50-column 4, line 13), provided within said enclosure for said imaging element, a lens selection means (motor 65 or thumbwheel 3), provided within said enclosure, for selecting one of said first lens and said second lens so that a focal point of a selected lens is established at said imaging element (Figure 6; column 10, line 33-58). Robb discloses that with the reading head in position 3, the user may capture data and/or images below the device such as fingerprints and signatures (column 3, line 64-column 4, line 3), and that the system preferably includes some form of user verification such as a signature or a fingerprint, but does not explicitly disclose a transparent plate to which a tip of a finger of an user of said portable information terminal device is attached, wherein said imaging element captures an image of a fingerprint of said tip of the finger on said transparent plate by said second lens selected by said lens selection means, or said lens selection being effected in association with a movement of at least one of said first lens and said second lens.

6. Borza discloses a fingerprint imaging apparatus with auxiliary lens including a transparent plate 26 to which a tip of a finger of a user of said device is attached, wherein an imaging element 28 captures an image of a fingerprint of said tip of the finger on said transparent plate 26 by a first lens 21 selected by said lens selection means 16 (Figure 1a; column 2, line 27-48). Borza goes on to disclose that the lens selection means (mounting plate) 16 effects lens selection in association with movement of at least one of said first lens 21 and said second lens 38 (Figure 1b; column 3, line 6-18). It would have been obvious to one of ordinary skill in the

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art at the time the invention was made to capture an image of a fingerprint of a finger attached to a transparent plate by a lens selected by lens selection means, wherein lens selection is affected in association with a movement of at least one of said first and second lenses as taught by Borza in order to verify a person's identity using a small video camera including an auxiliary lens to allow the camera to be used selectively for imaging object in the neighborhood of the apparatus, as well as for producing fingerprint images (column 1, line 36-42).

***Allowable Subject Matter***

7. Claims 2-8 and 11-13 are allowed.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan J Hesseltine whose telephone number is 703-306-4069. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ryan J. Hesseltine  
July 7, 2004

JINGGE WU  
PRIMARY EXAMINER

